



IN THE UNITED STATES PATENT AND TRADEMARK OFFICE
BEFORE THE BOARD OF PATENT APPEALS AND INTERFERENCES

Applicant : Daniel Judge
Serial No. : 10/068,078
Filed : February 5, 2002
Title : IDENTIFYING MARKER FOR END OF ROLLED PRODUCT

Art Unit : 2859
Examiner : Amanda J. Hoolahan

Mail Stop Appeal Brief - Patents
Hon. Commissioner for Patents
P.O. Box 1450
Alexandria, VA 22313-1450

BRIEF ON APPEAL

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(3) STATUS OF CLAIMS

Claims 1, 2, 4 and 9-14 have been canceled. Claims 3 and 5-7 stand finally rejected under 35 U.S.C. § 102(n) [sic] as being unpatentable over Thomason, claims 8, 19 and 22 stand finally rejected under 35 U.S.C. § 103(a) as unpatentable over Thomason, claims 15-18, 20, 21 and 23 stand finally rejected under 35 U.S.C. § 103(a) as unpatentable over Thomason as a primary reference in view of Johnson as a secondary reference, claim 25 stands finally rejected under 35 U.S.C. § 103(a) as unpatentable over Thomason as a primary reference in view of Clayton as a secondary reference, claim 27 stands finally rejected under 35 U.S.C. § 103(a) as unpatentable over Thomason as a primary reference in view of Clayton as a secondary reference. Claim 17 stands finally rejected under 35 U.S.C. § 103(a) as unpatentable over Thomason as a primary reference in view of Hollenberg as a secondary reference. Claim 28 stands finally rejected under 35 U.S.C. § 103(a) as unpatentable over Thomason as a primary reference in view of Kildoon as a secondary reference. Claims 24 and 26 are rejected, but the statutory basis for rejecting them has not been identified.

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(4) STATUS OF AMENDMENTS

No amendment has been filed subsequent to final rejection.

(5) SUMMARY OF INVENTION

The invention comprises a rolled product of contiguous separable sheets. At least first and second contiguous separable sheets of product are wound around an axis forming a cylindrical roll, such as 10, with each sheet having an outer edge positioned parallel to the axis. At least the first and second contiguous separable sheet of product has at least one indicium that bears a predetermined relationship when the first sheet is the outermost sheet of the rolled product such that a discontinuity of the indicium is likely to be formed between the outer edge of each sheet having the indicium and the portion of the indicium which lies directly beneath the outer edge of the sheet having the indicium when the sheets are formed into a cylindrical roll, wherein the indicium is a continuous undulating indicium, such as scroll 51 or 52. There may be a plurality of indicium, such as 51 and 52. The plurality of indicium may be out-of-phase from each other, such as 51 and 52. Each of the continuous undulating indicium may be sinusoid-shaped having a predetermined wavelength that may be substantially equal to L, such as 51 and 52. L may correspond to the length of a sheet.

A method for making a roll of contiguous separable sheets of product with a mark for visually locating the end of the roll according to the invention includes marking the sheets with at least one visually perceivable mark extending the length of each of the sheets continuously for the entire length of the roll, such as 51 or 52. The visually perceivable mark bears a predetermined relationship between the portion of the mark at the edge of each sheet and the portion of the mark that lies directly beneath each edge when the sheets are spooled onto a roll, such that a discontinuity is likely formed between the mark and any sheet edge and the portion of the mark which lies directly beneath the edge on the roll, thereby allowing the end of the rolled product to be visually located. Then spool the sheets into a cylindrical roll. The method may include marking the sheets with a plurality of marks, such as 51 and 52, that may be sinusoid-shaped and out-of-phase from one another. Each of the sheets may have a length equal to L with each of the sinusoid-shaped marks having a wavelength substantially equal to L.

(6) ISSUES

1. Whether claims 3 and 5-7 are unpatentable over Thomason under 35 U.S.C. §102(n) when Thomason fails to disclose each and every element in these claims arranged as in the claims.

2. Whether claim 8, 19 and 22 are unpatentable over Thomason under 35 U.S.C. § 103(a) when the reference fails to suggest the desirability of modifying what is there disclosed to meet the terms of claims 8, 19 and 22.

3. Whether claims 15-18, 20, 21 and 23 are unpatentable over Thomason as a primary reference in view of Johnson as a secondary reference under 35 U.S.C. § 103(a) when the references fail to suggest the desirability of combining what is there disclosed to meet the terms of these claims.

4. Whether claim 25 is unpatentable over Thomason as a primary reference in view of Clayton as a secondary reference under 35 U.S.C. § 103(a) when the references fail to suggest the desirability of combining what is there disclosed to meet the terms of these claims.

5. Whether claim 27 is unpatentable over Thomason as a primary reference in view of Hollenberg as a secondary reference under 35 U.S.C. § 103(a) when the references fail to suggest the desirability of combining what is there disclosed to meet the terms of this claim.

6. Whether claim 28 is unpatentable over Thomason as a primary reference in view of Killdoon as a secondary reference under 35 U.S.C. § 103(a) when the references fail to suggest the desirability of combining what is there disclosed to meet the terms of this claim.

7. Whether claims 24 and 26 were properly rejected when the final rejection fails to identify a statutory basis for rejecting the claim.

(7) GROUPING OF CLAIMS

The claims in the group consisting of claims 2, 5, 15-18, 20, 21 and 23 do not stand or fall together.

(8) ARGUMENT

I. APART FROM CLAIMS 3 AND 5-7 BEING REJECTED UNDER NONEXISTENT STATUTORY PROVISIONS, ASSUMING THE INTENDED REJECTION WAS THAT THESE CLAIMS ARE ANTICIPATED BY THOMASON, SUCH A REJECTION WOULD BE IMPROPER BECAUSE THOMASON FAILS TO DISCLOSE EACH AND EVERY ELEMENT SET FORTH IN THESE CLAIMS ARRANGED AS IN THESE CLAIMS.

The final rejection states:

Claims 3 and 5-7 are finally rejected under 35 U.S.C. 102(n) [sic] as being unpatentable by USPN 4,195,787 to Thomason.

Thomason discloses a rolled product of continuous separable sheets, comprising at least a first (A) and second (B) contiguous separable sheet of product wound around an axis (C), forming a cylindrical roll, each sheet having an outer edge positioned parallel to the axis; at least the first and second contiguous separable sheet (A, B) of product (11) having at least one indicium (14) that bears a predetermined relationship when the first sheet is the outer most sheet of the rolled product (11), such that a discontinuity of the indicium is likely to be formed between the outer edge of each sheet having the indicium and the portion of the indicium which lies directly beneath the outer edge of each sheet having the indicium when the sheets are formed into a cylindrical roll, wherein the indicium is a continuous undulating indicium (14', see Figure 4) (column 1, lines 22-23); at least the first and second sheet of contiguous separable sheets (A, B) of product (11) have a plurality of indicium (14, D); the plurality of indicium are out-of-phase from each other; the continuous undulating indicium are sinusoid-shaped (See Figure 4) having a predetermined wavelength. P. 2.

"It is well settled that anticipation under 35 U.S.C. 102 requires the presence in a single reference of all of the elements of a claimed invention." *Ex parte Chopra*, 229 U.S.P.Q. 230, 231 (BPA&I 1985) and cases cited.

"Anticipation requires the presence in a single prior art disclosure of all elements of a claimed invention arranged as in the claim." *Connell v. Sears, Roebuck & Co.*, 220 U.S.P.Q. 193, 198 (Fed. Cir. 1983).

"This court has repeatedly stated that the defense of lack of novelty (i.e., 'anticipation') can only be established by a single prior art reference which discloses each and every element of the claimed invention." *Structural Rubber Prod. Co. v. Park Rubber Co.*, 223 U.S.P.Q. 1264, 1270 (Fed. Cir. 1984), citing five prior Federal Circuit decisions since 1983 including *Connell*.

In a later analogous case the Court of Appeals for the Federal Circuit again applied this rule in reversing a denial of a motion for judgment n.o.v. after a jury finding that claims were anticipated. *Jamesbury Corp. v. Litton Industrial Prod., Inc.*, 225 U.S.P.Q. 253 (Fed. Cir. 1985).

After quoting from *Connell*, "Anticipation requires the presence in a single prior art disclosure of all elements of a claimed invention arranged as in the claim," 225 U.S.P.Q. at 256, the court observed that the patentee accomplished a constant tight contact in a ball valve by a lip on the seal or ring which interferes with the placement of the ball. The lip protruded into the area where the ball will be placed and was thus deflected after the ball was assembled into the valve. Because of this constant pressure, the patented valve was described as providing a particularly good seal when regulating a low pressure stream. The court quoted with approval from a 1967 Court of Claims decision adopting the opinion of then Commissioner and later Judge Donald E. Lane:

[T]he term "engaging the ball" recited in claims 7 and 8 means that the lip contacts the ball with sufficient force to provide a fluid tight seal. *** The Saunders flange or lip only sealingly engages the ball 1 on the upstream side when the fluid pressure forces the lip against the ball and never sealingly engages the ball on the downstream side because there is no fluid pressure there to force the lip against the ball. The Saunders sealing ring provides a compression type of seal which depends upon the ball pressing into the material of the ring. *** The seal of Saunders depends primarily on the contact between the ball and the body of the sealing ring, and the flange or lip sealingly contacts the ball on the upstream side when the fluid pressure increases. 225 U.S.P.Q. at 258.

Relying on *Jamesbury*, the ITC said, "Anticipation requires looking at a reference, and comparing the disclosure of the reference with the claims of the patent in suit. A claimed device is anticipated if a single prior art reference discloses all the elements of the claimed invention as arranged in the claim." *In re Certain Floppy Disk Drives and Components Thereof*, 227 U.S.P.Q. 982, 985 (U.S. ITC 1985).

These claims include the limitation that the indicium be continuous, such as 52 and 51, and as described on page 3 of the specification beginning at line 6. The reference fails to disclose this limitation, instead disclosing the discontinuity between the indicium spanning the four sheets shown in FIG. 4 of the reference and those on the fragmentarily illustrated sheets at each end.

"A reference is only good for what it clearly and definitely discloses." *In re Hughes*, 145 U.S.P.Q. 467, 471 (C.C.P.A. 1965); *In re Moreton*, 129 U.S.P.Q. 227, 230 (C.C.P.A. 1961).

Manifestly, the reference fails to disclose this limitation.

If this ground of rejection were repeated, the Examiner was respectfully requested to quote verbatim the language in the reference regarded as corresponding to the continuous undulating indicium or the visually perceivable mark extending continuously along the length of each of the sheets continuously for the length of the entire roll. The Examiner's response was set forth in the last four lines quoted above.

Column 1, lines 22-23 in the reference states, "Typically, any form of marking is repeated continuously along the length of the rolled product." (Emphasis added.) Thus, the reference, discloses not a continuous undulating indicium extending continuously along the length of each of the sheet continuously for the length of the entire roll as disclosed and claimed in this application, but a form of marking that is repeated continuously along the length of the rolled product each form of marking extending only along the length of a group of sheets in the roll and being repeated while having a discontinuity between contiguous repetitions as clearly shown in FIG. 4 with the wiggly marking, FIG. 3 with the straight line marking extending over four sheets, FIG. 2 with the straight line marking extending over four sheets and concluding along an intermediate four sheets of a group of six while terminating on a first and sixth and FIG. 1 showing a straight line extending over a group of four.

This reference failing to disclose the continuous undulating indicium over the length of the roll, it cannot disclose the plurality of continuous indicium that extend over the length of the roll, or the plurality of such contiguous indicium that are out-of-phase from each other.

What the Examiner is doing is using the claims being rejected as a blueprint or template for attempting to read the claims being rejected upon the prior art. That approach is not a proper basis for rejecting claims.

The alleged teaching is found, not in the references but in the claims being rejected. It is error to reconstruct the claimed invention from the prior art by using the rejected claim as a "blueprint." *Interconnect Planning Corp. v. Feil*, 227 U.S.P.Q. 543, 548 (Fed. Cir. 1985).

Here, the Examiner relied upon hindsight to arrive at the determination of obviousness. It is impermissible to use the claimed invention as an instruction

manual or "template" to piece together the teachings of the prior art so that the claimed invention is rendered obvious.¹⁵ This court has previously stated that "[o]ne cannot use hindsight reconstruction to pick and choose among isolated disclosures in the prior art to deprecate the claimed invention."¹⁶ *In re Fritch*, 23 U.S.P.Q. 2d 1780, 1784 (Fed. Cir. 1992).

¹⁵ *In re Gorman*, 933 F.2d 982, 987, 18 USPQ2d 1885, 1888 (Fed. Cir. 1991). See also *Interconnect Planning Corp. v. Feil*, 774 F.2d 1132, 1138, 227 USPQ 543, 547 (Fed. Cir. 1985).

¹⁶ *In re Fine*, 837 F.2d at 1075, 5 USPQ2d at 1600.

II. CLAIM 8 MEETS THE CONDITIONS FOR PATENTABILITY AT LEAST BECAUSE THE REFERENCE FAILS TO SUGGEST THE DESIRABILITY OF MODIFYING WHAT IS THERE DISCLOSED TO MEET THE TERMS OF CLAIM 8.

The final rejection states:

Claim 8 is finally rejected under 35 U.S.C. 103(a) as being unpatentable over Thomason.

Thomason discloses the rolled product as described above in paragraph 2 including the sheets being of length L.

Thomason does not disclose the particular value of the wavelength of each of the sinusoid-shaped indicium being substantially equal to L.

With respect to the particular value of the wavelength of each of the sinusoid-shaped indicia being substantially equal to L: To make the wavelength of each of the sinusoid-shaped indicia being substantially equal to L, this is only considered to be the "optimum" value of the wavelength of each sinusoid-shaped indicium disclosed by Thomason, as stated above, that a person having ordinary skill in the art at the time the invention was made would have been able to determine using routine experimentation based, among other things, on the desired accuracy and since it has been held that discovering an optimum value of a result effective variable involves only routine skill in the art. See *In re Boesch*, 205 USPQ 215 (CCPA 1980). Therefore, it would have been obvious to a person having ordinary skill in the art at the time the invention was made to make the wavelength of each of the sinusoid-shaped indicia being substantially equal to L in order to save on manufacturing costs by imprinting a lesser amount of sinusoidal-shaped indicia on the rolled product. P. 3.

"The mere fact that the prior art could be so modified would not have made the modification obvious unless the prior art suggested the desirability of the modification." *In re Gordon*, 221 U.S.P.Q. 1125, 1127 (Fed. Cir. 1984).

The reliance on *In re Boesch*, 205 U.S.P.Q. 215 (C.C.P.A. 1980) is inapposite. There the court observed the board agreed with the examiner that the claimed alloys were *prima facie* obvious where there was no substantial disagreement that both references disclose alloys having compositional limits overlapping those of the claimed alloy. Here the reference has no comparable disclosure of the claimed invention and fails to suggest the desirability of modifying what is disclosed to meet the terms of the rejected claims.

We have shown above that the reference fails to disclose the indicium extending continuously along the length of the roll, and nothing in the reference suggests the desirability of modifying what is there disclosed to make each of the sinusoid-shaped marks have a wavelength substantially equal to L.

If this ground of rejection were repeated, the Examiner was respectfully requested to quote verbatim the language in the reference regarded as corresponding to each element in claim 8, and quote verbatim the language regarded as suggesting the desirability of modifying what is disclosed in the reference to meet the terms of claim 8. The Examiner did not and can not comply with this request.

III. CLAIMS 15-18, 20, 21 AND 23 MEET THE CONDITIONS FOR PATENTABILITY AT LEAST BECAUSE IT IS IMPOSSIBLE TO COMBINE WHAT IS DISCLOSED IN THESE REFERENCES TO MEET THE TERMS OF THESE CLAIMS, AND NOTHING IN THESE REFERENCES SUGGEST THE DESIRABILITY OF COMBINING WHAT IS THERE DISCLOSED TO MEET THE TERMS OF THESE CLAIMS.

The final rejection states:

Claims 15-18, 20-21, and 23 are finally rejected under 35 U.S.C. 103(a) as being unpatentable over Thomason in view of USPN 6,282,807 to Johnson.

Thomason discloses the rolled product as described above in paragraph 2 wherein normal manufacture of the device comprises the method steps of making a roll of contiguous separable sheets of product with a mark for visually locating the end of the roll comprising marking the sheets with at least one visually perceivable mark extending the length of each of the sheets, the visually perceivable mark bearing a predetermined relationship between the portion of the mark at the edge of each sheet and the portion of the mark that lies directly beneath each edge when the sheets are spooled onto a roll, such that a discontinuity is likely formed between the mark at any sheet edge and the portion of the mark which lies directly beneath the edge on the roll, thereby allowing the

end of the rolled product to be visually located and spooling the sheets into a cylindrical roll; marking the sheets with a plurality of marks; the plurality of marks are each sinusoid-shaped; each of the sinusoid-shaped marks are out of phase from one another; the sheets being toilet paper (column 1, line 15); the sheets are paper toweling (column 1, line 9); the mark is printed on the sheets.

Thomason does not disclose the perceivable mark being continuous for the entire length of the said roll.

Johnson discloses a rolled product that has a perceivable mark that is continuous for the entire length of said roll. Therefore, it would have been obvious to a person having ordinary skill in the art at the time the invention was made to make the perceivable mark, as taught by Thomason, to be continuous for the entire length of the roll, as taught by Johnson, in order for the device to be simpler to manufacture since it would only require the marking device to stay in one place, rather than restart the marking process every four sheets. Pp. 4-5.

"The mere fact that the prior art could be so modified would not have made the modification obvious unless the prior art suggested the desirability of the modification." *In re Gordon*, 221 U.S.P.Q. 1125, 1127 (Fed. Cir. 1984).

"Although the Commissioner suggests that [the structure in the primary prior art reference] could readily be modified to form the [claimed] structure, '[t]he mere fact that the prior art could be so modified would not have made the modification obvious unless the prior art suggested the desirability of the modification.'" *In re Laskowski*, 10 U.S.P.Q. 2d 1397, 1398 (Fed. Cir. 1989).

"The claimed invention must be considered as a whole, and the question is whether there is something in the prior art as a whole to suggest the desirability, and thus the obviousness, of making the combination." *Lindemann Maschinenfabrik GMBH v. American Hoist & Derrick*, 221 U.S.P.Q. 481, 488 (Fed. Cir. 1984).

"Obviousness cannot be established by combining the teachings of the prior art to produce the claimed invention, absent some teaching or suggestion supporting the combination. Under Section 103, teachings of references can be combined only if there is some suggestion or incentive to do so." *ACS Hospital Systems, Inc. v. Montefiore Hospital*, 221 U.S.P.Q. 929, 933 (Fed. Cir. 1984) (emphasis in original, footnotes omitted).

"The critical inquiry is whether 'there is something in the prior art as a whole to suggest the desirability, and thus the obviousness, of making the combination. [citing *Lindemann* with emphasis added.]" *Fromson v. Advance Offset Plate, Inc.*, 225 U.S.P.Q. 26, 31 (Fed. Cir. 1985).

As the Federal Circuit Court of Appeals said in *In re Dembiczak*, 175 F.3d 994, 999 (Fed. Cir. 1999):

Close adherence to this methodology is especially important of less technologically complex inventions, where the very ease with which the invention can be understood may prompt one 'to fall victim to the insidious effect of a hindsight syndrome wherein that which only the inventor taught is used against its teacher.'

And in *In re Kotzab*, 55 U.S.P.Q.2d 1313, 1316 (Fed. Cir. 2000), the Court said:

[I]dentification in the prior art of each individual part claimed is insufficient to defeat patentability of the whole claimed invention. See *id.* [*Dembiczak*]. Rather, to establish obviousness based on a combination of the elements disclosed in the prior art, there must be some motivation, suggestion or teaching of the desirability of making the specific combination that was made by the applicant. See *In re Dance*, 160 F.3d 1339, 1343, 48 U.S.P.Q.2d 1635, 1637 (Fed. Cir. 1998), *In re Gordon*, 733 F.2d 900, 902, 221 U.S.P.Q. 1125, 1127 (Fed. Cir. 1984). Even when obviousness is based on a single prior art reference, there must be a showing of a suggestion or motivation to modify the teachings of that reference. See *B. F. Goodrich Co. v. Aircraft Braking Sys. Corp.*, 72 F.3d 1577, 1582, 37 U.S.P.Q.2d 1314, 1318 (Fed. Cir. 1996).

We have shown above that the primary reference fails to disclose the limitation in all these claims calling for the visually perceivable mark extending the length of each of the sheets continuously for the entire length of the roll, and the secondary reference fails to overcome this shortcoming. It is thus impossible to combine the primary and secondary references to meet the terms of claims 15-18, 20, 21 and 23.

"Moreover, we observe that even if these references were combined in the manner proposed by the examiner, that which is set forth in appellant's claims . . . would not result." *Ex parte Bogar*, slip op. p.7 (BPA&I Appeal No. 87-2462, October 27, 1989). "Even if we were to agree with the examiner that it would have been obvious to combine the reference teachings in the manner proposed, the resulting package still would not comprise zipper closure material that terminates short of the end of the one edge of the product containing area, as now claimed." *Ex parte Schwarz*, slip op. p.5 (BPA&I Appeal No. 92-2629 October 28, 1992). "Although we find nothing before us indicating why it would be desired to combine the references in the manner

urged by the examiner, it is clear to us that such a modification by itself would not result in that which is set forth in the claims.” *Ex Parte Kusko*, 215 U.S.P.Q. 972, 974 (BPA&I 1981).

That it is impossible to combine the references to meet the terms of these claims is reason enough for reversing the final rejection of them.

IV. CLAIMS 19 AND 22 MEET THE CONDITIONS FOR PATENTABILITY AT LEAST BECAUSE THOMASON FAILS TO SUGGEST THE DESIRABILITY OF MODIFYING WHAT IS THERE DISCLOSED TO MEET THE TERMS OF THESE CLAIMS.

The final rejection states:

Claims 19 and 22 are finally rejected under 35 U.S.C. 103(a) as being unpatentable over Thomason.

Thomason discloses the rolled product as described above in paragraph 2 including the sheets being of length L.

Thomason does not disclose the particular value of the wavelength of each of the sinusoid-shaped indicium being substantially equal to L.

With respect to the particular value of the wavelength of each of the sinusoid-shaped indicia being substantially equal to L: To make the wavelength of each of the sinusoid-shaped indicia being substantially equal to L, this is only considered to be the “optimum” value of the wavelength of each sinusoid-shaped indicium disclosed by Thomason, as stated above, that a person having ordinary skill in the art at the time the invention was made would have been able to determine using routine experimentation based, among other things, on the desired accuracy and since it has been held that discovering an optimum value of a result effective variable involves only routine skill in the art. *In re Boesch*, 205 USPQ 215 (CCPA 1980). Therefore, it would have been obvious to a person having ordinary skill in the art at the time the invention was made to make the wavelength of each of the sinusoid-shaped indicia being substantially equal to L in order to save on manufacturing costs by imprinting a lesser amount of sinusoidal-shaped indicia on the rolled product. P. 5.

These claims positively recite the visually perceivable mark extending continuously along the length of each of the sheets continuously along the entire length of the roll that is absent from the primary reference, and no contention is made that the reference discloses that the wavelength of the sinusoidal marking correspond to the length of each sheet. We have shown above that reliance on *Boesch* is inapposite, and nothing in the reference suggests the desirability of modifying what is there disclosed to meet the terms of claims 19 and 22. If this ground of

rejection were repeated, we respectfully requested the Examiner to quote verbatim the language in the reference regarded as corresponding to each element in claims 19 and 22 and quote verbatim the language regarded as suggesting the desirability of modifying what is disclosed in the reference to meet the terms of claims 19 and 22. We have shown above that the Examiner failed to find in the reference a disclosure of the limitation of the visually perceivable mark extending continuously along the length of each of the sheets continuously along the entire length of the roll, nor did the Examiner quote any language in the reference suggesting the desirability of modifying what is there disclosed to meet the terms of claims 19 and 22.

V. CLAIM 25 MEETS THE CONDITIONS FOR PATENTABILITY AT LEAST BECAUSE NOTHING IN THE PRIMARY OR SECONDARY REFERENCES SUGGESTS THE DESIRABILITY OF COMBINING WHAT IS THERE DISCLOSED TO MEET THE TERMS OF CLAIM 25, AND IS IMPOSSIBLE TO COMBINE WHAT IS DISCLOSED THERE TO MEET THE TERMS OF CLAIM 25.

The final rejection states:

Claim 25 is finally rejected under 35 U.S.C. 103(a) as being unpatentable over Thomason in view of USPN 4,076,121 to Clayton et al. [hereinafter Clayton].

Thomason discloses a rolled product of contiguous separable sheets as described above in paragraph 2.

Thomason does not disclose the sheets being plastic bags.

Clayton discloses a rolled product being separable sheets of plastic bags. Therefore, it would have been obvious to a person having ordinary skill in the art at the time the invention was made to use the indicia disclosed by Thomason with a rolled product comprised of separable sheets of plastic bags, as taught by Clayton, in order to determine the free end of the rolled product and since Thomason already suggests that the indicia could be used with products manufactured in a rolled form (Column 1, lines 1-10). P. 6.

Claim 25 is dependent upon and includes all the limitations of claim 20, and the reasoning set forth above in support of the patentability of claim 20 is submitted to support the patentability of claim 25 so that further discussion is submitted to be unnecessary. Nevertheless, it is impossible to combine the primary and secondary references to meet the terms of claim 25, and that is reason enough for reversing the final rejection of the claim. Nor do the references suggest the desirability of combining what is disclosed there to meet the terms of claim 25.

VI. CLAIM 27 MEETS THE CONDITIONS FOR PATENTABILITY AT LEAST BECAUSE IT IS IMPOSSIBLE TO COMBINE THE PRIMARY AND SECONDARY REFERENCES TO MEET THE TERMS OF CLAIM 27, AND NOTHING IN THESE REFERENCES SUGGESTS THE DESIRABILITY OF COMBINING WHAT IS THERE DISCLOSED TO MEET THE TERMS OF CLAIM 27.

The final rejection states:

Claim 27 is finally rejected under 35 U.S.C. 103(a) as being unpatentable over Thomason in view of USPN 6,221,211 to Hollenberg et al. [hereinafter Hollenberg].

Thomason discloses a rolled product of contiguous separable sheets as described above in paragraph 2.

Thomason does not disclose the mark being dyed on the sheets.

Hollenberg discloses a tissue product having a mark that is dyed on the sheets (17). Therefore, it would have been obvious to a person having ordinary skill in the art at the time the invention was made to have the indicia dyed on the sheets, as taught by Hollenberg, instead of imprinted, as taught by Thomason, since the way that the indicia is added to the rolled product, absent of any criticality, is considered to be nothing more than a choice of engineering skill, choice or design because 1) neither non-obvious nor unexpected results, i.e., results which are different in kind and not in degree from the results of the prior art, will be obtained as long as the indicia is added to the rolled product as already suggested by Thomason, and 2) the use of the particular way of adding the indicia claimed by Applicant, is considered to be nothing more than the use of one of numerous and well known alternate types of markings that a person having ordinary skill in the art would have been able to provide using routine experimentation in order to permanently add the indicia on the rolled product. Pp. 6-7.

Claim 27 is dependent upon and includes all the limitations of claim 20, and the reasoning set forth above in support of the patentability of claim 20 is submitted to support the patentability of claim 27 so that further discussion of claim 27 is submitted to be unnecessary. We have shown above that the primary reference fails to disclose the visually perceivable mark extending continuously along the length of each of the sheets continuously along the entire length of the roll, and the secondary reference does not overcome this deficiency. It is therefore impossible to combine these references to meet the terms of claim 27, and that is reason enough

for reversing the final rejection of this claim. Nor is there any suggestion in the references of combining what is there disclosed to meet the terms of claim 27.

VII. THE OFFICE ACTION FAILS TO IDENTIFY A STATUTORY BASIS FOR REJECTING CLAIMS 24 AND 26.

The final rejection includes an "X" in box 6 under the heading of Disposition of Claims stating claims 3, 5-8, 15-28 are rejected. But nothing in the remainder of the office action includes a statutory basis for rejecting claims 24 and 26. Since claims 24 and 26 are dependent upon and includes all the limitations of claim 20, had there been a statutory basis for rejecting claims 24 and 26, it would have been overcome at least for the reasoning set forth above in support of the patentability of claim 20.

CONCLUSION

In view of the foregoing authority, remarks and the inability of the prior art alone, or in combination, to anticipate, suggest or make obvious the subject matter as a whole of the invention disclosed and claimed in this application, the decision of the Examiner finally rejecting claims 3, 5-8 and 15-28 should be reversed. Should the Board be of the opinion that a claim may be allowed in amended form, the Board is respectfully requested to include an explicit statement that such claim may be allowed in such amended form and direct that Appellant shall have the right to amend in conformity with such statement in the absence of new references or grounds of rejection.

Applicant : Daniel Judge
Serial No. : 10/068,078
Filed : February 5, 2002
Page : 15 of 18

Attorney's Docket No.: 13808-002001

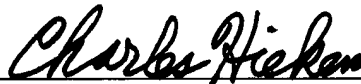
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(9) APPENDIX OF CLAIMS

3. A rolled product of contiguous separable sheets, comprising:

at least a first and second contiguous separable sheet of product wound around an axis, forming a cylindrical roll, each sheet having an outer edge positioned parallel to the axis; and

at least the first and second contiguous separable sheet of product having at least one indicium that bears a predetermined relationship when the first sheet is the outer most sheet of the rolled product, such that a discontinuity of the indicium is likely to be formed between the outer edge of each sheet having the indicium and the portion of the indicium which lies directly beneath the outer edge of each sheet having the indicium when the sheets are formed into a cylindrical roll,

wherein the indicium is a continuous undulating indicium.

5. A rolled product of contiguous separable sheets, comprising:

at least a first and second contiguous separable sheet of product wound around an axis, forming a cylindrical roll, each sheet having an outer edge positioned parallel to the axis; and

at least the first and second contiguous separable sheet of product having at least one indicium that bears a predetermined relationship when the first sheet is the outer most sheet of the rolled product, such that a discontinuity of the indicium is likely to be formed between the outer edge of each sheet having the indicium and the portion of the indicium which lies directly beneath the outer edge of each sheet having the indicium when the sheets are formed into a cylindrical roll,

wherein at least the first and second sheet of contiguous separate sheets of product have a plurality of indicium,

wherein the plurality of indicium are each a continuous undulating indicium.

6. The rolled product of claim 5 wherein the plurality of indicium are out-of-phase from each other.

7. The rolled product of claim 6 wherein each of the continuous undulating indicium are sinusoid-shaped having a predetermined wavelength.

8. The rolled product of claim 7 wherein the sheets are of length L and the wavelength of each of the sinusoid-shaped indicium are substantially equal to L.

15. A method for making a roll of contiguous separable sheets of product with mark for visually locating the end of the roll, comprising:

marking the sheets with at least one visually perceivable mark extending the length of each of the sheets continuously for the entire length of said roll, the visually perceivable mark bearing a predetermined relationship between the portion of the mark at the edge of each sheet and the portion of the mark that lies directly beneath each edge when the sheets are spooled onto a roll, such that a discontinuity is likely formed between the mark at any sheet edge and the portion of the mark which lies directly beneath the edge on the roll, thereby allowing the end of the rolled product to be visually located; and

spooling the sheets into a cylindrical roll.

16. The method of claim 15, further comprising marking the sheets with a plurality of marks.

17. The method of claim 16, wherein the plurality of marks are each sinusoid-shaped.

18. The method of claim 17, wherein each of the sinusoid-shaped marks are out-of-phase from one another.

19. The method of claim 18, wherein each of the said sheets have a length equal to L and each of the sinusoid-shaped marks have a wavelength substantially equal to L.

20. A roll of contiguous separable sheets of product comprising a visually perceivable mark extending continuously along the length of each of the sheets continuously along the entire length of said roll and forming a pattern such that a discontinuity is likely formed between the mark at any sheet edge and the portion of the mark which lies directly beneath the edge on the roll, thereby allowing the end of the rolled product to be visually located.

21. The roll of claim 20, further comprising a plurality of undulating visually perceivable marks extending continuously along the length of the sheets.

22. The roll of claim 21, wherein the plurality of visually perceivable marks are sinusoid-shaped with a wavelength equal to the length of each sheet.

23. The roll of product of claim 20 wherein the sheets are toilet paper.

24. The roll of product of claim 20 wherein the sheets are paper toweling.

Applicant : Daniel Judge
Serial No. : 10/068,078
Filed : February 5, 2002
Page : 18 of 18

Attorney's Docket No.: 13808-002001

25. The roll of product in claim 20 wherein the sheets are plastic bags.
26. The roll of product in claim 20 wherein the mark is printed on the sheets.
27. The roll of product in claim 20 wherein the mark is dyed on the sheets.
28. The roll of product in claim 20 wherein the mark is embossed on the sheets.